

## REMARKS

Applicants appreciate the continuing detailed examination evidenced by the second Office Action mailed June 2, 2004 (hereinafter the Office Action). Applicants also appreciate the Examiner's indication that all of Claims 1-8, 10-29, 31-50, and 52-63 have been examined, and that the sole ground of rejection of these claims is a provisional statutory double patenting rejection under 35 USC §101 as claiming the same invention as that of Claims 1, 3-9, 11-12, 14-16, 19-22, 24-30, 32-33, 35-37, 40, 43, 45-51, 53-54, 56-58, and 61-63 of copending U.S. Patent Application No. 09/422,431 ("the '431 application"). Independent Claims 1, 22, and 43 have been amended herein to further clarify why they are not coextensive in scope to independent Claims 1, 22, and 43 of the '431 application.

Applicants note that with respect to the double patenting rejections based on 35 U.S.C. § 101, M.P.E.P. § 804 provides:

A reliable test for double patenting under 35 U.S.C. § 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent [or related pending patent application]. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). Is there an embodiment of the invention that falls within the scope of one claim, but not the other? If there were such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting would not exist.

Amended Claim 1 of the present application recites:

computer-readable program code for creating an output document in which each element of said interim transient document for which markup notation has been added is encrypted in a manner that *enables each community member that is authorized to view that element to use key distribution material associated with the output document to decrypt the encrypted element, and that precludes decryption of the encrypted element by unauthorized community members.* (Emphasis added.)

In contrast, amended Claim 1 of the '431 application recites:

computer-readable program code for creating an output document in which each element of said interim transient document for which markup notation has been added is encrypted in a manner that *enables a key recovery agent to decrypt each of said encrypted elements*, wherein key distribution material associated with said output document is used as input to said decryption. (Emphasis added.)

Applicants respectfully submit that the above-recited portion of Claim 1 of the present application is not claiming identical subject matter as recited by Claim 1 of the '431 application. In particular, in Claim 1 of the present application, the output document is encrypted so that only authorized community members can decrypt the document using the key distribution material associated with the output document, and unauthorized community members are precluded from doing so. In contrast, in Claim 1 of the '431 application, the output document is encrypted so that a key recovery agent can decrypt each of the encrypted elements. Accordingly, although the key recovery agent may be a community member, it is a special type of community member that is authorized to decrypt all of the encrypted elements of the output document.

Thus, Claim 1 of the present application may be literally infringed without literally infringing Claim 1 of the '431 application. Accordingly, under the test provided by M.P.E.P. § 804, identical subject matter is not defined by both claims and statutory double patenting does not exist. Accordingly, Applicants respectfully request withdrawal of the provisional statutory double patenting rejection of Claim 1.

Independent Claims 22 and 43 have been amended to contain similar recitations as amended Claim 1, and are respectfully submitted to not be coextensive with respective Claims 22 and 43 of the '431 application for the reasons explained above for Claim 1.

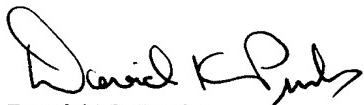
Since dependent Claims 2-8, 10-21, 23-29, 31-42, 44-50, and 52-63, by definition, also include the recitations of the independent claims from which they dependent, Applicants also request withdrawal of the statutory double patenting rejection of Claims 2-8, 10-21, 23-29, 31-42, 44-50, and 52-63.

In re: Davis et al.  
Serial No.: 09/422,430  
Filed: October 21, 1999  
Page 24

**CONCLUSION**

In light of the above amendments and remarks, Applicants respectfully submit that the above-entitled application is now in condition for allowance. Favorable reconsideration of this application, as amended, is respectfully requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (919) 854-1400.

Respectfully submitted,



David K. Purks  
Registration No. 40,133  
Attorney for Applicant(s)

USPTO Customer No. **46589**  
Myers Bigel Sibley & Sajovec, P.A.  
Post Office Box 37428  
Raleigh, NC 27627  
Telephone: (919) 854-1400  
Facsimile: (919) 854-1401